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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,842	06/01/2001	Akira Masumura	645-145	3721
47888	7590	12/27/2004		
HEDMAN & COSTIGAN P.C. 1185 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER SAMPLE, DAVID R	
			ART UNIT	PAPER NUMBER
			1755	

DATE MAILED: 12/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/872,842	MASUMURA ET AL.	
	Examiner	Art Unit	
	David Sample	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1755

DETAILED ACTION

Any rejections and/or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn. The rejection over US Patent No. 3,769,613 is hereby withdrawn in view of the amendment to the Al_2O_3 range.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

Claims 9-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Miwa et al. (US Patent No. 5,057,464).

This rejection is a new rejection that was not made in the previous action. It was necessitated by the amendment filed October 15, 2004.

Miwa et al. discloses glass compositions with amounts of components that fall within the ranges of components of instant claims 9 and 10. See the table bridging col's 3-4, Examples 1, 2, and 4-10.

The reference fails to disclose the property recited in instant claim 11. However, a glass's properties are determined by its composition, and the composition of the reference is identical to the presently claim composition. Therefore, the property of claim 11 is assumed to be inherent to the composition of the reference. See MPEP 2112.

It is noted that the reference requires the presence of CeO_2 whereas the present claims employ "consisting essentially of" claim language. "Consisting essentially of" claim language limits a claim to the recited ingredients and any ingredients, which do not materially affect the

Art Unit: 1755

novel and/or basic characteristics of the invention. See MPEP 2111.03. There is nothing of record to suggest that the addition of CeO₂ affects the novel and/or basic characteristics of the present invention.

Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Speit et al. (US Patent No. 4,520,115).

This rejection is over a reference that was used to reject the claims in the previous action; however, it is considered a new ground of rejection because the rejection is over the general disclosure of the reference, rather than the examples.

Speit et al. discloses a glass composition having ranges of components that are sufficiently specific to anticipate the ranges of components of instant claims 9, 10, 12 and 13. See MPEP 2131.03 and the abstract, and col. 3, line 40 to col. 3, line 7.

The reference fails to disclose the property recited in instant claim 11. However, a glass's properties are determined by its composition, and the composition of the reference is identical to the presently claim composition. Therefore, the property of claim 11 is assumed to be inherent to the composition of the reference. See MPEP 2112.

It is noted that the reference requires the presence of CeO₂ whereas the present claims employ "consisting essentially of" claim language. There is nothing of record to suggest that the addition of CeO₂ affects the novel and/or basic characteristics of the present invention.

Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Dalton et al. (US Patent No. 2,964,414).

This rejection is over a reference that was used to reject the claims in the previous action; however, it is considered a new ground of rejection because the rejection is over the general disclosure of the reference, rather than the examples.

Dalton et al. discloses a glass composition having amounts of components that are sufficiently specific to anticipate the ranges of components of instant claims 9, 10, 12, and 13. See MPEP 2131.03 and col. 4, line 59 to col. 5, line 11.

The reference fails to disclose the property recited in instant claim 11. However, a glass's properties are determined by its composition, and the composition of the reference is identical to the presently claim composition. Therefore, the property of claim 11 is assumed to be inherent to the composition of the reference. See MPEP 2112.

It is noted that the reference requires the presence of Rb_2O whereas the present claims employ "consisting essentially of" claim language. There is nothing of record to suggest that the addition of Rb_2O affects the novel and/or basic characteristics of the present invention.

Claims 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al. (US Patent No. 2,762,713).

This rejection is over a reference that was used to reject the claims in the previous action; however, it is considered a new ground of rejection because the rejection is over the general disclosure of the reference, rather than the examples.

Davis et al. discloses a glass composition with amounts of components that are sufficiently specific to anticipate the ranges of components of instant claims 9, 10, 12 and 13. See MPEP 2131.03 and col. 1, lines 57-58.

The reference fails to disclose the property recited in instant claim 11. However, a glass's properties are determined by its composition, and the composition of the reference is identical to the presently claim composition. Therefore, the property of claim 11 is assumed to be inherent to the composition of the reference. See MPEP 2112.

It is noted that the reference requires the presence of ZnO whereas the present claims employ "consisting essentially of" claim language. There is nothing of record to suggest that the addition of ZnO affects the novel and/or basic characteristics of the present invention.

Response to Arguments

Applicant's arguments filed October 15, 2004 have been fully considered but they are not persuasive.

To some extent, applicants' arguments are moot in view of the new grounds of rejection. However, the examiner will answer the arguments to the degree that they pertain to the new grounds for rejection.

Applicants argue that the amended ranges overcome the rejections made in the previous Office action. This argument is deemed persuasive with respect to the Examples of the references. However, the new grounds for rejection are based upon the general disclosure of the references rather than the examples. The general disclosure of the references has ranges of components that closely overlap the amended ranges.

Applicants assert that the "consisting essentially of" language precludes the addition of CeO₂, Rb₂O and ZnO (as disclosed by Speit et al., Dalton et al. and Davis et al., respectively) to the present claims. As noted above, "consisting essentially of" claim language limits a claim to

the recited ingredients and any ingredients, which do not materially affect the novel and/or basic characteristics of the invention. See MPEP 2111.03. For purposes of examination, “consisting essentially of” should be treated like “comprising” (lacking a clear indication in the specification of what the novel characteristics are). *Id.* The burden of establishing that a particular ingredient is precluded by “consisting essentially of” lies with the applicants, and can be done by pointing out in the specification how the additional ingredient would materially affect the novel and/or basic characteristics of the invention. *Id.* There is no indication in the current record that CeO₂, Rb₂O or ZnO would materially affect the novel and/or basic characteristics of the present invention.

Conclusion

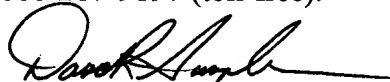
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Sample whose telephone number is (571)272-1376. The examiner can normally be reached on Monday to Thursday and alternate Fridays.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David Sample
Primary Examiner
Art Unit 1755